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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/199,320	11/25/1998	JOHANN KLEIN	Q051986	3573

7590

05/08/2003

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EXAMINER

HAROLD, JEFFEREY F

ART UNIT

PAPER NUMBER

2644

14

DATE MAILED: 05/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/199,320

Applicant(s)

KLEIN, JOHANN

Examiner

Jefferey F. Harold

Art Unit

2644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6 and 8-14 is/are rejected.
- 7) ☒ Claim(s) 5 and 7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 2644

DETAILED ACTION

1. The request filed on March 12, 2003, for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/199,320 is acceptable and a CPA has been established. An action on the CPA follows.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. ***Claims 1-4, 6, and 8-14*** are rejected under 35 U.S.C. 102(e) as being anticipated by Yablon (United States Patent 5,764,731).

Regarding **claim 1**, Yablon discloses a system for transferring, storing and using signaling information in a switched telephone network. In addition Yablon discloses a process of transmitting a telephone number of a desired subscriber from a directory assistance operator to a telephone connected to the directory assistance operator over

a switched telephone network with a voice channel for voice conversation and data channel for data transmission, as disclosed at column 11, line 65 through column 12, line 63 and exhibited in figure 1, the process comprising:

a primary telephone user calls directory assistance and asks for a telephone number to be conveyed to him or her via the voice channel, as disclosed at column 6, lines 5-10;

the directory assistance operator transmits the telephone number via DTMF, which reads on claimed "numeric string", from the directory assistance operator to the primary user's telephone over the data channel, as disclosed at column 12, lines 10-63 and exhibited in figures 1-4;

receiving the numeric string at the primary user's telephone and storing the telephone number in the telephone memory for direct dialing of the telephone numbers, as disclosed at column 15, lines 1-65 and exhibited in figure 3.

Regarding **claim 2**, Yablon discloses everything claimed as applied above (see claim 1), in addition Yablon discloses whereby the directory assistance operator also issues an action command (START code) that causes the terminal to determine the telephone number from the DTMF signals and to save the telephone number in the memory in the primary user's telephone for direct dialing of telephone numbers, as disclosed at column 15, line 50 through column 16, line 2 and exhibited in figure 3.

Regarding **claim 3**, Yablon discloses everything claimed as applied above (see claim 1), in addition Yablon discloses whereby the telephone number is displayed on a

display in the user's telephone, as disclosed at column 11, line 65 through column 12, line 12 and exhibited in figure 1.

Regarding **claim 4**, Yablon discloses everything claimed as applied above (see claim 1), in addition Yablon discloses wherein the telecommunication network is an ISDN network and the second channel is a data channel, which reads on claimed "D channel", of the ISDN network, as disclosed at column 12, lines 52-68.

Regarding **claim 6**, Yablon discloses everything claimed as applied above (see claim 1), in addition Yablon discloses whereby the directory assistance operator sends the character string, which reads on "data describing the desired subscriber as an alpha-numeric string", to the user's telephone on the second channel, the user's telephone number receives the character string, derives the data from the character string, and displays it on the display, as disclosed at column 11, line 65 through column 12, line 9; column 12, lines 52-68 and column 15, line 50 through column 16, line 2 and exhibited in figures 1-4.

Regarding **claims 8-14**, Yablon discloses everything claimed, in addition, claims 8-14 and interpreted and thus rejected for the reason set forth above in the rejection of claims 1-4 and 6.

Allowable Subject Matter

3. **Claims 5 and 6** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jefferey F. Harold whose telephone number is (703) 306-5836. The examiner can normally be reached on Monday-Friday 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Forester W. Isen can be reached on (703) 305-4386. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.


JFH
May 2, 2003


FORESTER W. ISEN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600